

No. 3004.

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IN THE  
**United States Circuit Court of Appeals**  
FOR THE NINTH CIRCUIT

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SIMPLEX WINDOW COMPANY,

vs.

Appellant,

HAUSER REVERSIBLE WINDOW COMPANY, et al.,

Appellees.

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**BRIEF FOR APPELLEES**

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BRIEF FOR APPELLEES.

The general statement of the proceedings in this case is fairly stated in the appellant's brief; hence, we will at once take up the questions involved in this appeal, as we understand them.

The questions are:

1st: As to the validity of the first, fourth and seventh claims of the Soule patent, now before the Court;

2nd: Whether or not the defendant's patented device is an infringement of either of said claims.

Appellees claim that each of these claims is void for want of invention and patentable novelty, and that if either of them is valid the appellees' device does not infringe either of said claims. The three claims sued upon are for precisely the same structure and in our analysis of the appellant's alleged invention we will confine ourselves especially to Claim 1, because what may be said of Claim 1 applies to the other two. It may be said in passing, however, that the fourth claim of the patent is clearly too broad; taking it literally, it would cover a device absolutely inoperative. It is so broad that, as it reads, it would cover an adjuster arm fixedly pivoted at one end to the frame, and at the other end to said sash, and a carrier arm fixedly pivoted at one end to said frame, and at the other end to said adjuster arm. This is not the structure of either the appellant or the appellees, and would be wholly inoperative. But, of course, in construing the claim reference has to be made to the specification and it could only cover the structure described or plain mechanical equivalents. What is said in regard to that claim, we ask to be applied to claims "4" and "7."

Claim "1" comprises the following elements:

- (a)—A window comprising
- (b)—A frame, a sash slidably pivoted in said frame,
- (c)—Adjuster arms, one end of which being fixedly pivoted at points slightly above the

middle of the sash stiles, and the other end slidably pivoted in the frame,

- (d)—Carrier arms, one end of which is fixedly pivoted in the frame and the other end fixedly pivoted to the corresponding adjuster arm.

The controversy hinges around the adjuster arm "7" and the carrier arm "4."

Looking at Fig. 1 of the drawings the claimed construction is readily comprehended. The sash is slidably fixed in the frame at the top, the adjuster arm "7" is fixedly pivoted at "9" to the sash at a point slightly above the middle, and the other end slidably pivoted at "12" to the frame or jamb of the frame. The idea of the inventor, of the functions to be performed by this element is clear. If he desired to adjust the sash "3" it was thought necessary that one end of this arm should give by a sliding motion, otherwise the arm and the sash would (it was supposed) remain stationary, so he arranged the lower end of his adjuster arm in a groove in the jambs with certain slidable fixtures in such a manner that when the sash was closed the lower end would slide down at the lower end of the jamb, and the sash would occupy its first stage of stable equilibrium (folio 80, second column of the patent), and when it was desirable to raise the sash, the lower end of the arm would slide upward to "12," and the sash would then be in a second position of stable equilibrium (folio 85, sec-

ond column of patent). It is evident that at this point the only force that held the adjuster arm and sash in an open or fixed stable position was the frictional force of the slidable devices in the slot at "12." It is also evident that the only function of this arm was to adjust the sash to any desired position and hold it there. It is also equally apparent that if the slidable devices at "12" are of sufficient strength and tension, which they would have if properly constructed, the adjuster arm and sash will be held in any desired position to meet all ordinary uses. There is no novelty or invention in this arrangement alone, for window frames with a single arm fixedly pivoted to the jamb at the lower end and fixedly pivoted to the sash at the upper end are now and have been in public use all over the country for many years, as will hereafter be shown. In this old construction the sash is slidably pivoted to the frame and as the sash is raised or lowered for the purposes of adjustment it slides up and down in the frame. This construction is an entirely operative device. The foregoing statement, as to the operation of adjuster arm "7," is borne out by the language of the specification at folio "85," second column, page "1," where it is said:

"It (the sash) is given stable equilibrium in other positions (other than the closed position) by the adjuster arm '7'."

This, of course, is a natural result of having one end pivoted to the sash and the other slidably pivoted to

the jamb by means of the frictional devices specifically described. The friction of these frictional devices at "12," being amply sufficient to hold the sash in stable equilibrium for all practical and useful purposes.

These sliding fixtures are shown in Figs. "4," "5" and "7," but their peculiar construction is not involved here.

Taking up the third element of this claim, we find it described at folio "100," second column, page "1" of the specification as follows:

"For further securing the general equilibrium described and for allowing the window (sash) to be readily shifted from one position to another, I provide carrier arm '4,' one end of which is pivoted to the corresponding adjuster arm '7' by pivot '10,' at a point about  $\frac{1}{3}$  the length of said arm measured from the point '9.' The other end of the carrier arm '4' is pivoted to the frame by means of the pivot '6,' etc."

At first blush one reading this description would naturally suppose there was something in it, but a moment's thought, with a little analysis, and it fades into a mere shade of a shadow. Let us see: it is asserted that this carrier arm is for the purpose of securing the "general equilibrium." What does the inventor mean by the "general equilibrium"? We are already told that the sash is given stable equilibrium by the arm "7"; so, without the carrier arm "4" the sash is in stable equilibrium. This means that the

sash or window was firmly established, not easily moved or shaken. (See page "37," Tr.) This being so, what useful purpose would be subserved by "further securing the general equilibrium"? We fail to see how this arm with both ends fixedly pivoted, one end to the adjuster arm and the other to the jamb or frame, can affect in any manner the stable equilibrium caused by the adjuster arm "7." It is evident that the carrier arm "4" is wholly controlled by the adjuster arm "7." When the latter is caused to slide up or down by the application of force to the sash to overcome the resistance caused by the slidably frictional devices at "12," it moves up or down in unison with it. Take off the carrier arm, what happens? Nothing. The adjuster arm and sash operate just the same; the sash is adjusted to any desired position and its stable equilibrium is maintained. But, take off the adjuster arm and the whole thing falls to pieces. At the same folio "100" it is also said that this carrier arm allows the window (sash) to be readily shifted from one position to another. But, is this statement correct? The shifting of the sash is unquestionably accomplished and wholly accomplished by the adjuster arm "7," which carries the sash, shifts or adjusts it to the desired position and holds it there in a state of stable equilibrium. This arm "4" can perform no function whatever in shifting the position of the window sash. It is shifted and adjusted just as well, and in the same way, and for the same purpose, with or



without it. Even the name "carrier arm" is misleading, for it carries nothing; on the contrary, it is (itself) carried by the adjuster arm "7" and the sash. Every angle, from a vertical line in the jamb to its normal position, as shown in Fig. 1, is entirely regulated by arm "7," with its slidable fixtures at "12." If you slide arm "7" down from the normal point "12"—say half way—then arm "4" takes a midway position and so on, until the lower end of arm "7" reaches the bottom of the window frame, when it assumes a vertical position in the jamb. Is it not obvious that the arm "4" is shifted and adjusted in various positions by the action of arm "7," and that arm "4" performs no function whatever in the combination described and claimed?

Claim "7" calls for a carrier arm, *supporting* said adjuster arm. This supporting function is nowhere mentioned in the description, but as a matter of fact is it true?

We assert that this carrier arm "4" gives no support whatever to the adjuster arm "7." It was never contemplated that it should act as a support to the adjuster arm or to the sash. What support can it give to the sash or adjuster arm, when the moment weight is applied to the sash, which is superior to the frictional resistance at "12," the window closes as already shown, without any reference to the arm "4"; the said arm "4" being pivotally connected to the arm "7" and the jamb at "6" cannot in our judgment give

any support either to the sash "3" of the window or to the arm "7." This suggestion is clearly demonstrated by the specifications and drawings of the Soule-Larsen patent (appearing on pages "90," "91," "92" and "93" of the transcript), which was pending in the Patent Office at the same time as the Soule patent now in controversy. The Soule of the Soule-Larsen patent is the same person as the Soule of the patent now in controversy.

In Figure "2" of the drawings of the Soule-Larsen patent you see the same adjuster arm which is at "16," fixedly connected at the lower end of the frame, and the other end is fixedly pivoted to the sash at "17." The action of this arm "16" in the Soule-Larsen patent is identically the same as the supporting arm "24" of the Hauser patent. It is constructed the same way, operates the same way and accomplishes the same result and no more and no less. Hauser's right to the use of this arrangement of the arm cannot be denied.

In Figure "1" Soule-Larsen patent you will see the sash being held in a fixed equilibrium by the arm "16," and the slidable fixtures at the upper end of the sash, while the other arm "25" hangs loosely.

At folio "120," second column, second page of the Soule-Larsen patent (page "92," Tr.), we find the following description of this arm "16":

"By the described construction, the sash swings entirely to one side of the frame; and by the frictional activity of the frictional guide and the sup-

porting action of the arm '16,' the sash is stably fixed in any position desired, without counter-weight."

The frictional guide here referred to is the guide devices at the upper end of the sash and which slide in the grooves "5" and support therein the sash in whatever position it may be adjusted (See Col. 1, second page Soule-Larsen patent). This is made still clearer by Claim "1" of the Soule-Larsen patent, which reads as follows:

"In combination with a window frame having grooves therein, a sash adapted to operate in said frame, carrier arms adapted to support the central portion of the sash, an arm connected to the sash, the said arm adapted to engage the carrier arm and lock the sash in an open position."

This arm is the little notched arm "25" shown in Fig. "1," and in many other places, which is fixedly pivoted to the sash and notched in such a manner as to engage a lug on the arm "16" (called the carrier arm in this patent) and lock and *rigidly* hold the sash in its desired position.

This Soule-Larsen patent clearly discloses that the purpose of the adjuster arm "7" in the Soule patent, with its frictional slidable devices at "12," and the so-called carrier arm "16" of the Soule-Larsen patent, with the frictional slidable guides at the upper end of the sash, perform identically the same function—that of adjusting the sash in an open position; that

they are the only features which adjust it in any desired position, and that the carrier arm "4" in one, or the notched arm "25" in the other has nothing to do with it whatever; that neither of these arms performs any function in the operation of the device; strengthens nothing; supports nothing; adjusts nothing, and has nothing whatever to do with the shifting of the sash from one position to another. Is it not obvious that adjuster arm "7" in the one and the carrier arm "16" with frictional guide in the other are the controlling operative elements of the two structures?

Again, assuming for a moment that the adjuster arm "7" of the Soule patent required some additional support or strength, we insist that any person of ordinary common sense—whether a mechanic or not—would, without the exercise of any inventive faculty, either strengthen the adjuster arm by adding more material to it, or greater resistance in its frictional devices, or by the numerous other means by which it could be strengthened or supported; the adding of any support or assistance in shifting the window which could be given by this arm certainly is not a matter requiring any invention, but solely an act of ordinary intelligence.

"The mere enlargement of parts, or the strengthening of the stable parts of a structure, or the placing of braces in the frame work in a machine

to enable it to stand up to its work is not invention”:

*Schweichler vs. Levinson* (147 Fed. Rep., pp. 704-707).

*Brouch vs. Roemer* (103 U. S., p. 797);  
*Star Bucket Pump Co. vs. Butler Mfg. Co.*  
 (198 Fed. Rep., pp. 856-863);  
*Barnes Co. vs. Vandyck Co.* (213 Fed., p. 636);  
*Rose Mfg. Co. vs. Whitehouse Mfg. Co.* (201  
 Fed., pp. 926-928);  
*In re Ferres* (192 O. G., p. 745).

Taking each of the elements involved, which is the only way to get down to the real questions, Hauser's supporting arm "24" is not the equivalent of the Soule arm "7," because it is differently constructed and arranged, and it does not perform the same functions in any single respect; the fixedly pivoted arm of the Hauser patent cannot perform the functions of the slidably pivoted arm of the Soule patent. We urge this point, because it seems to us that it is, of itself, absolutely fatal to the appellant's case.

The appellant's arm "4" has no slidable frictional device and cannot slide; if it was made slidable, it would make a monstrosity; it does not in any sense lock, partially lock or retard the movement of the arm "7" or the sash, while the link of the appellees does perform these functions just detailed; they are not interchangeable, the one with or for the other;

you cannot transpose arm "4" and pivot it to Hauser's sash and supporting arm; you cannot put Hauser's frictional, slidably pivoted link to the frame of the window, as Soule does—either case would be a disastrous failure.

The difference in the structure of these two devices is accentuated by the fact hereinbefore stated, that the Soule sash has two points of slidability, to wit: at the lower end of arm "7" at "12" and at the upper end of the sash, where it is attached to the frame; while, in the appellees' structure there is but one point of slidability, affecting the adjustment of the sash to any desired position.

For these, and other reasons that will hereafter appear, we urge that Claims "1," "4" and "7" of the patent are absolutely void for want of invention. Confessedly the function of the adjuster arm "7" is to shift and support the sash in any desired position. We cannot conceive how it can be invention to increase these functions by simply adding some other increasing element.

This conclusion it seems to us is made absolutely apparent, and is the only logical result from a consideration and comparison of the two patents. It must be remembered that the Soule-Larsen patent, so-called, of which the said Soule was the real inventor, as appears from his own testimony in the transcript, was applied for October 31st, 1911, and that the Soule patent was applied for on August 21st,

1912, and that the applications for both patents were pending in the patent office at the same time. Consequently, Soule knew at the time that he made his application for the Soule patent in August, 1912, that the so-called carrier arm "16" of the Soule-Larsen patent, acting in conjunction with the slidable frictional guides connecting the sash at its upper end to the frame, permitted the sash to be shifted and stably fixed in any position desired without counterweight (See folio 120, second column, second page Soule-Larsen patent, at page "92," Tr.).

Concerning the identity of these devices Mr. Vale says:

"According to my idea, there is absolutely no difference in the device represented by one of these models; absolutely none; and any common mechanic could take one and from that build the other without any invention at all, because all the elements are present and all the functions are present and the mode of operation is practically the same. So far as the elements are concerned, the device described in the Soule-Larsen patent is the same as that described in the Soule patent. The only difference is the difference of arrangement. The two devices that are described in the Soule patent and the Larsen-Soule patent are substantially the same."

If the testimony of this expert is true as here given, how could there be any inventive skill required in adding the so-called carrier arm "4," instead of the locking arm "25"?



Again all of these claims, that is: "1," "4" and "7," are merely aggregations and not true combinations.

We contend that it is clear that the combinations, as shown in all of the claims, of a window frame, a sash in said frame, with an adjuster arm, one end of which is fixedly pivoted slightly above the middle of the sash stiles, and the other end slidably pivoted in the frame at its lower end, and one wherein the sash may be readily moved from one position to any other position, as desired, and remains in the state of stable equilibrium, in whatever position the sash may be placed, omitting entirely from the structure both the notched arm "25" of the first patent and arm "4" of the other patent constitute a window of the swinging reversible sash type.

This question of invention has been so often before the Courts that it may seem to be a waste of time and mental pabulum to collate cases on the subject. But, at the risk of criticism, we will call the attention of the Court to a few cases which we think control the subject.

We will first call the attention of the Court to the case of

*Gould & Eberhardt vs. Cincinnati Shaper Co.*  
(194 Fed. Rep., page 680),

which was a case quite similar in principle and in the facts to the case at bar, and where at the bottom of



page "685" the Court of Appeals of the Sixth Circuit said:

"The evidence also indicates that apart from the 'self contained' features, the device in suit has utility, being especially useful where the metal to be worked is very heavy, or the thrust of the tool unusually great; and that it has been favorably received by manufacturers and users, having to a large extent taken the place of old constructions.

"It is insisted by complainant that the considerations above stated show invention, as distinguished from mere mechanical skill. Ordinarily, the mere making in one piece of a device, or part of a device, formerly made in two pieces, is not invention. But, the bringing together of previously separated parts in a unitary organization, so that they act together and produce a more beneficial result than when the parts operate separately, may be invention. But, where, as here, the elements operate in no different way, and have no different relation to each other when in a self-contained form than *when one element is detached, such combination is not invention.*"

Citing:

*Standard Caster Co. vs. Caster Socket Co.*

113 Fed. Rep., p. 162; 51 C. C. A., 109);

*National Tube Company vs. Aiken* (163 Fed.

Rep., pp. 254-261; 91 C. C. A., 114);

*Herman vs. Youngstown Car Mfg. Co.* (191

Fed. Rep., p. 579).

The same rule is also laid down in the very next case in the 194 Fed. Rep. *Sheffield Car Co. vs. D'Arcy*, where at page "693" it is said:

"It is, furthermore, clear that a combination of old elements, to be patentable, must produce a new force, effect or result as the product of the combined forces, as distinguished from a mere aggregation of the results of the old elements, each working out its separate effect, and that a combination consisting merely of old parts and of old results, without the addition of any new and distinct function, is not patentable."

Citing:

*Reckendorfer vs. Faber* (92 U. S., 347; 23 L. Ed., 719) ;

*Goodyear Rubber Co. vs. Rubber Wheel Co.* (116 Fed. Rep., pp. 363-369) ;

*National Cash Register Co. vs. Register Co.* (53 Fed. Rep., p. 371).

"This doctrine applies, not merely when the old elements are separately used in the combination, but also when they are integrally combined in one device involving mere mechanical knowledge and producing no new result differing from the aggregate result of the former separate elements."

When we consider for a moment that this patented window as a whole, or as to any of the parts of it, produces no new result and that the result (that is a reversible window sash) is old, and that Soule was in no sense a pioneer in this art, for it is a very old art, and that

such windows of various forms, shapes and construction have been in public use, as will be seen from the file wrapper of the Soule-Larsen patent on file in this Court (but not printed in the transcript by stipulation), it must be apparent that there is no new or distinct function produced by the said carrier arm "4," and that the claims in suit are for mere aggregations and not patentable.

Mechanical adaptation not invention, and is not patentable:

*Dunbar vs. Meyers* (94 U. S.; 24 Law Ed., 34).

Merely bringing old devices together in juxtaposition and then allowing each to work out its own effect without the production of something novel is not invention:

*Pickering vs. McCullough* (104 U. S., p. 318).

A patent covering a combination of old elements to produce a device new in form, but old in function, having no new mode of operation is void for want of invention:

*Greist vs. Parsons* (125 Fed. Rep., p. 116), and cases cited page 119.

Where the field of invention has been narrowed by many prior devices in the same art, a patent for a new combination must be narrowly construed, and limited to the precise structure shown. A

wide range of equivalents is out of the question; a broad construction of the claim is not permissible:

*Kenney Mfg. Co. vs. J. L. Mott Iron Works*

(137 Fed. Rep., p. 431).

(See cases cited at middle page 434.)

A patent not being a pioneer, the owner is not entitled to a broad range of equivalents. The claim must be limited in their scope to the actual combination of essential parts as shown, and cannot be construed to cover other combinations of elements or different construction and arrangement:

*St. Louis Street Machine Co. vs. American*

*Street Machine Co.* (156 Fed. Rep., p. 580),  
and cases cited.

In the celebrated case of *Kokomo Fence* (189 U. S., p. 8; 47 Law Ed., p. 689; 135 Fed. Rep., p. 520), at page 531 (Fed. Rep.) it is said:

"That the patent not being a pioneer its claims must be limited in their scope to the actual combination of essential parts as shown and cannot be construed to cover other combinations of elements of different construction and arrangement."

And, agains the Court said:

"The claims of a patent covering a mere improvement upon prior machines which were capable of accomplishing the same general result must receive a narrow construction."

Citing:

*Morley Machine Co. vs. Lancaster* (129 U. S.,  
p. 263; 32 Law Ed., p. 715).

The law is well settled as to equivalents:

“Mechanical equivalents as understood in connection with infringements of patents are such devices as were known previously, and which in the particular combination of devices specified as constituting the patented invention, can be adapted to perform the functions of those specified devices for which they are employed as substitutes without changing the inventor’s idea of means: in other words, without introducing an original idea producing as the result of it an improvement which is itself a patentable invention.”

*Jensen Can Filling Machine Co. vs. Norton*  
(67 Fed., pp. 236-239; 14 C. C. A., p. 383).

“Equivalent in the patent law means that the patent in respect to each of the respective ingredients comprising the invention covers every other ingredient which in the same arrangement of the parts will perform the same function if it was well known as a proper substitute for the one described in the patent at the date thereof.”

*Norton vs. Jensen* (49 Fed. Rep., pp. 859-868;  
1 C. C. A., p. 452).

“It is an abuse of the term ‘equivalent’ to employ it to cover every combination or device in a machine which is used to accomplish the same result.”

*Beach vs. Hobbs* (92 Fed. Rep., pp. 146-150;  
34 C. C. A., p. 248).

Citing:

*Westinghouse vs. Boyden Power Brake Co.*  
(170 U. S., p. 537; 18 Sup. Ct., p. 707; 42  
Law Ed., p. 1136);

*Burr vs. Duryee* (17 Law Ed. U. S., pp. 650-  
658).

In the Westinghouse case, i. d., the Court said:

“The argument that every combination of devices which is used to produce the same result is necessarily an equivalent is a flagrant abuse of the term equivalent.”

“Mechanical equivalent must be adaptable to use as a substitute for something else, and competent to perform the functions of a particular device for which it may be substituted.”

*Alaska Packing Co. vs. Letson* (119 Fed. Rep.,  
599).

It seems to be obvious that Soule's original conception of a reversible window is clearly described in his first patent applied for October 31st, 1911, and the device therein described, with its carrier arm “16” and its notched arm locking device, which had been made by him, and numerous of them were in public use before his application for his second patent applied for August 21st, 1912, consequently is a part of the prior art, so far as this second patent is concerned. Therefore, the second patent showing its so-called carrier arm “4” could be nothing more than a mere

carrying forward of the original conception shown in the said first patent. In cases of this kind the law is well settled that the mere carrying forward of an original conception resulting in an improvement in degree is not invention:

*Keene vs. New Idea Spreader Company* (231 Fed. Rep., p. 701).

Again, it is said (speaking of the patent then in use) :

“It is merely carrying forward the original conception, which Fawcett patented—a new and more extended application of it—involving change only in form, proportion or degree.”

The Supreme Court in *Smith vs. Nichols* (21 Wall., p. 112), said “that this was not such invention as would sustain a patent.” The patent was held void in the case from which the foregoing quotation is taken.

See:

*Theberath vs. Rubber & Celluloid Harness Trimming Company* (15 Fed. Rep., bottom p. 251).

Another important feature of the plaintiff's carrier arm “4” is found at folios “10” and “15,” first column,

second page of the patent (page 99, Tr.), which reads as follows:

"The lower part of carrier arm '4' is curved as shown in the drawing (Figs. 1 and 7). The reason for curving the end is to allow the window to close, the position of the pivot 10 being then at a point to the left of the pivot 6, and directly above pivot 11."

This is shown at "10" of Figure "1" of the drawings. This seems to be an important feature in the structure; it being for the purpose of allowing the window to close. Any structure that would not permit the window to close would not be a successfully operative device.

#### PRIOR ART.

The prior art before the Court consists in the Frot-scher patent (appellees' Exhibit "B"), also the devices designated in the record as "the awning device," the model being marked "*Defendants' Exhibit I*," and the single arm device made and sold by Hauser for many years, together with what is shown in the file wrapper of the Soule-Larsen patent.

This prior art shows adjuster arms (sometimes called supporting arms, carrier arms or their equivalents, as in Frotscher), pivotal guides of most every description and arranged in almost countless different ways, so as to operate a window sash along the lines shown in the appellant's patents. Consequently, if the

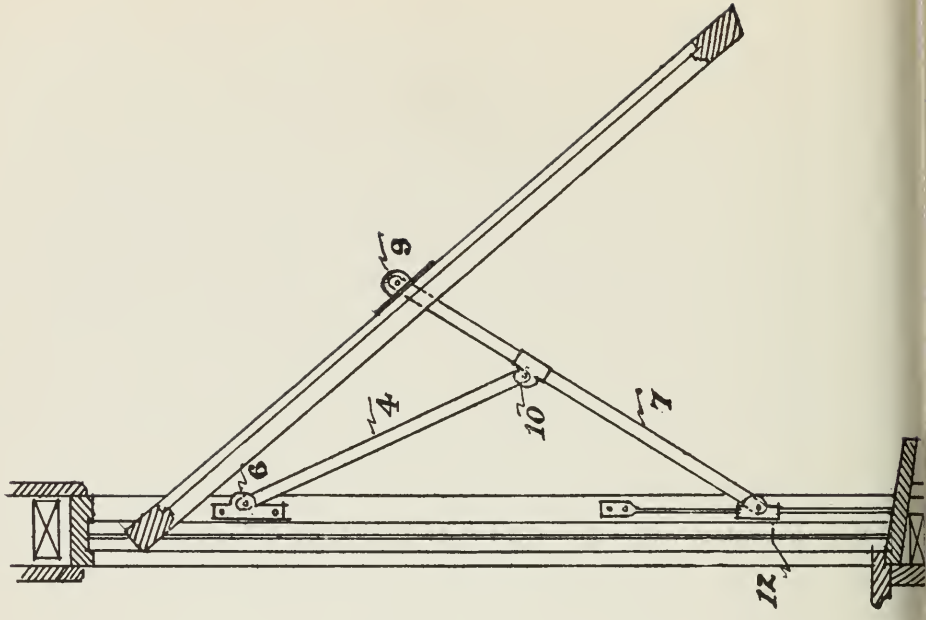
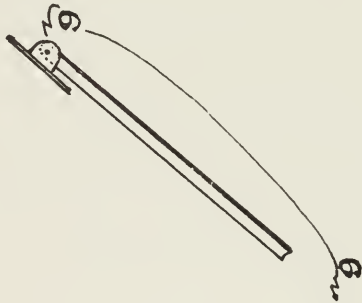
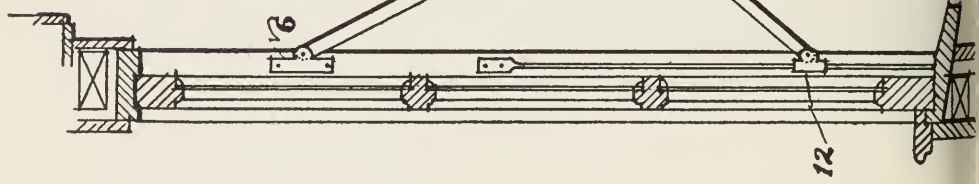




AWNING ARM

MODEL  
EXHIBIT I

AWNING DEVICE  
ATTACHED TO JASH



claims are good at all they are good only for the precise devices described in the claims sued upon.

#### FROTSCHER PATENT.

This patent shows that reversible windows were not novel at the time of the appellant's application. It shows a slidable sash, to be swung out if desired for cleaning or other purposes; it shows means for holding the sash inclined for ventilation and cleaning, so that the results to be accomplished are the same as in all of these later patented devices; the sashes are adapted to slide in the frame and are hung upon cords or chains, with weights; the cords running over a pulley arranged in the stile in any known way. While this patent is quite suggestive, we do not claim that it fully anticipates the appellant's patented device (this Frotsher patent is found at page 106, Tr.). (See testimony of Hauser, page 49, Tr.)

#### AWNING DEVICE.

As to the awning device, we think that discloses every feature, mechanical and structural, of the Soule device, except possibly in some very minor details of construction, which are unimportant upon the question of invention.

On the opposite page will be found a photographic drawing of this device and another showing the same structure with the sash of a window attached to it. Its

bearing upon the case is self-evident and needs no comment.

The operation of the single arm device is shown in the testimony of Vale at page 33, Tr., and also in the testimony of Hauser.

If the Court should feel disposed to go any further with the question of the prior art, we would respectfully call the attention of the Court to the file wrapper of the Soule-Larsen patent, which by stipulation was not printed, but it was agreed that the same should be used at the hearing of this cause, the same as if it had been printed.

The first application for a patent in that case contained sixteen claims—all for different structures and different arrangements of devices for reversible windows, from the single arm device upward. It appears from the file wrapper that the main desire of the applicant was to obtain a patent on some sort of a single arm device, but after four years' fight in the patent office he was driven to accept the notched arm device heretofore referred to. The patentee was familiar with all these structures and while it is not a history of the patent in suit, it is part of the evidence in this case, and has a very pertinent bearing upon the state of the art of the present patent.

We desire to call the attention of the Court to a few cases without commenting further on the subject:

In the case of *Sheffield Car Co. vs. D'Arcy* (194 Fed. Rep., 686-693), the Court said:

"A combination of old elements to be patentable must produce a new force, effect or result as the product of the combined forces as distinguished from a mere aggregation of results of the old elements, each working out its separate effects."

"When two inventors improve upon the former art, each in his own distinct and separate way, each shall be credited with his own improvement":

*Duncan vs. Cincinnati, etc.* (171 Fed., p. 665);

*Westinghouse vs. Boyden* (170 U. S., p. 537;

42 Law Ed., p. 1136).

In *Gould & Eberhardt vs. Cincinnati Shaper Co.* (194 Fed. Rep., p. 680, and cases cited), it was held:

"A combination of old elements which operate in no different way and have no different relation to each other when in combination than when one element is detached is not invention."

In *Pickering vs. McCullough* (104 U. S., p. 318) it is said:

"In a patentable combination of old elements, all the constituents must so enter into it, that each qualifies every other. It must form either a new machine of a distinct character and function; or produce a result due to the joint and co-operating action of all the elements, and which is not a mere adding together of several contributions."

“It is a familiar rule that in a patent for an improvement in an old art the claims must be limited to the precise construction or device mentioned in the claim”:

*Boyd vs. Janesville, etc.* (158 U. S., p. 260);  
*Farmers vs. Spruks Mfg. Co.* (127 Fed., p.

691);

*Topliff vs. Topliff* (145 U. S., p. 156).

## INFRINGEMENT.

It is claimed that the defendant infringes the said Soule patent by making and selling a reversible window such as shown in his patent, dated October 20th, 1914, No. 1,114,260, appearing in the transcript at pages "101," "102" and "103." There are several models of this device and various phases of it on file, but the drawings in Figure "1," page "101," Tr., discloses the structure and operation of the device so clearly that it would seem useless to refer to anything else. This structure shows an arm "24," which is pivoted to the frame at the lower end at "28" and the upper end is also pivoted to the sash, precisely as arm "16" of the Soule-Larsen patent, and holding it in position. It is evident that this arm "24" in the appellees' device of itself performs no other function than supporting the sash in whatever position it may be placed, and that it has nothing whatever to do with the shifting of the sash from one position to another, as called for by the adjuster arm "7" in the plaintiff's patent, and that said arm cannot perform any of the functions called for by the arm "7" of the plaintiff's patent. The reason is apparent: the lower end of this arm being pivoted to the frame, and the upper arm pivoted to the sash without any slidable features at either end, can act only as a mere supporting arm.

It is also claimed by the plaintiff that the link "19" of the defendant's patent is the equivalent of arm "4"

of the plaintiff's patent. This cannot be, for the reason that arm "4" is pivoted to the frame at "6" and the adjuster arm at "10," and has no slidable features in or about it whatever, while in the appellees' case the link "19" is pivoted close up to the upper end of its supporting arm "24" and *slidably pivoted* to the sash at "18," so that when the sash is to be adjusted by a change of position from a vertical to an angular line, the necessary force is applied to the sash it slides up or down at the upper end for adjustment and the link "19" slides along the slot in the sash designated as "17" for retardation. It follows from this that the link "19" performs none of the functions of arm "4" of the Soule patent.

It must be remembered, however, that this link "19" does not, on account of its slidability, or for any other reason, act as a support to the sash, or the supporting arm "24"; its only function is in the nature of a retarding device and to some extent, perhaps, retards the sash in its upward or downward movement. The only slidable feature in this patent, affecting the sash, is the same as in the Soule-Larsen patent; that is: the upper end of the sash is slidably attached to the frame and when the sash is raised or lowered it slides up or down, as the case may be. The removal of link "19" does not affect in any manner the functions of the arm "24" or the slidability of the sash.



At folio "60" of the specification of the Hauser patent, second column, first page, it is said:

"The ends of said spring 21 bear against the under side of the flat bar 8 and create sufficient friction thereagainst, to prevent the window sash moving from any position to which it has been turned. . . .

"By this construction it results that if there is sufficient friction caused by frictional engagement of the spring 18 with the slotted bar 5, said window sash will remain in any position to which it has been opened, notwithstanding that there is no direct support for said window sash."

It is obvious from this language of the Hauser patent that the sole function of this link or arm "19" is to retard the movement of the sash after it had been adjusted by the force applied to the sash; a sort of locking device, more like the notched locking arm of the Soule-Larsen patent than the arm "4" of the Soule patent.

Now, when the notched, or locking arm of the Soule-Larsen patent is removed, and the link "19" of the Hauser patent is removed, the two devices are the exact counterparts of each other, and the action of the arm "16" of the Soule-Larsen patent and arm "24" of the Hauser patent is precisely the same. So that all Hauser did was to take the carrier arm "16" of the Soule-Larsen patent and attach it to the frame and the sash in the same way.

There can be no infringement of the Soule patent by the appellees' device, for the further reasons:

Arm "24" being the exact counterpart of the carrier arm "16" of the Soule-Larsen patent, and having no slidable connection with the frame at its lower end, as the arm "7" in the Soule patent, the construction is different, the mode of operation is different, and the result accomplished by this arm "24" is wholly different. Assuming that the contention of the plaintiff is correct, which we deny, that arm "4" of the Soule patent supports arm "7" and further secures the general equilibrium desired and allows the window to be readily shifted from one position to another, it must be seen at once that link "19" performs no such functions; it has nothing to do with the general equilibrium of the device as a whole, or otherwise; it has nothing whatever to do with the shifting of the sash, nor does it have anything to do with supporting the arm "4" or the sash; it is absolutely barren of all such functions. The only thing that can be said of it is: that it is merely a retarding device which, owing to the friction that may be in the frictional device at "18," will retard the up and down motion of the sash and tend to hold it in any given position. In other words: this link "19" is more of a brake than anything else which we can compare it to. It will be observed further that you could not attach arm "4" to the sash and make it work; it would lock itself and go to smash, and this is conceded by all parties.

In order to make it work, you would have to remove the slidable device of the Soule patent at "12" and fixedly attach arm "7" to the frame at some suitable point; you would then have to put into the sash the peculiarly constructed guide and slidable fixtures shown at "18," "21" and "22" of the Hauser patent. There is no interchangeability between arm "7" of appellant's patent and arm "24," or between arm "4" and link "19," of appellees' patent, which is an important test.

*Ball Bearing Co. vs. Start Ball Retainer Company* (147 Fed., p. 721).

Suppose this suit was by Hauser against the appellant, could it be said that arm "7" was the same as arm "24," or that arm "4" was the same as arm or link "19"?

#### APPELLEES' PATENT.

It is conceded that the appellees have made and sold devices according to the description contained in said Hauser patent No. 1,114,260, dated October 20th, 1914. It is, of course, a junior patent, being later in date than the Soule patent. This fact, together with what has already been said, it would seem to us, should justify the Court in affirming the judgment below.

The Supreme Court in the case of *Corning vs. Burden* (15 How., 265) said:

“It is not easy to perceive why the defendant who uses a patented machine should not have the benefit of a like presumption in his favor, arising from a like investigation of the originality of his invention, and the judgment of the public officers that his machine is new, and not an infringement of the patent previously granted to the plaintiff.”

While there are many decisions affirming the rule here laid down, we will not cite them any further, because this Court is familiar with the rule, as this quotation is taken from the case of *Ransome et al. vs. Hyatt* (69 Fed. Rep., p. 148), the opinion in said case being written by His Honor, Judge Gilbert. With this presumption in our favor, we can see no reason why the judgment should be reversed.

#### APPELLANT'S BRIEF.

The appellant relies for its hope of reversal upon one sole legal proposition, which we admit to be good law in those cases where it applies; the proposition relied upon is stated in the first five lines of Section 348, *Walker on Patents*, and for the convenience of the Court we will reproduce that portion of it copied in the appellant's brief, to wit:

“Changing the relative position of the parts of a machine or manufacture does not avert infringement, where the parts transposed perform the same respective functions after the change as before.”

But, counsel failed to quote the whole of the rule stated in that section. The next paragraph of the section reads as follows:

“But changing the relative positions of the parts of a machine does avert infringement, where the changing of those positions so changes the functions of the parts, that the machine acquires a substantially different mode of operation, even though the result of the machine remains the same. A suit for infringement cannot be sustained against him who makes, uses, or sells a substantially different combination, even though it includes exactly the same ingredients as those claimed in combination by the patent in suit. The owner of a patent for a combination cannot suppress a newer, better and substantially different combination of the same ingredients.”

Our contention is that the rule stated in this last part of the section clearly controls this case. As we view it, it is not a question of the changing of the relative position of the parts but a question of the re-arrangement and re-construction of the whole machine.

Take arm “7” of the one and arm “24” of the other; no change in the position of these arms has taken place; but, they are entirely reconstructed and rearranged, owing to the fact of the slidable frictional connections of 7 and the omission of these devices from arm “24.” There must necessarily be a change in function and mode of operation between a rigidly pivoted arm and a slidable pivoted arm which performs a certain function that the other arm

cannot perform. Of course, the same thing may be said of arm "4" and link "19."

The appellee Hauser, under his patent, has made and sold devices of a substantially different combination. Even though we admit, which we deny, that the two devices include the same ingredients, for reasons which we think have already been made apparent; and we contend further that the Hauser device is entirely and substantially a different combination of the ingredients, even though they should be held to be the same.

The footnotes to the foregoing section cite many cases in support of the rule, but it is so well known and so well established that we do not think it necessary to comment upon them.

Mr. Miller cites and comments upon several cases in his brief, sustaining and illustrating the rule contended for by him—some of them are very old cases, but so far as we can see throw no light upon the proposition.

It must be remembered that Soule accomplished no new result whatever, but he accomplished an old result in a way slightly different in the mechanical construction from what preceded him, which differences we contend were all within the range of mechanics and did not involve invention.

Soule, at least by the patent in suit, was not the first to discover or apply the idea of a slidable or

reversible window sash; he did not discover or invent the idea of having the sash slidable at the top; he did not discover or invent the idea of an adjuster or supporting arm; he did not discover or invent the idea of having a supporting arm slidably connected with the frame at the bottom; he did not discover or invent the idea of having a carrier arm; he did discover that these ingredients combined in the way he described would produce a reversible window sash. If he invented anything, which we say he did not, it was simply the specific construction and arrangement of his adjuster arm and carrier arm as described in the specification, which we do not use. Hence, according to our view, none of the cases cited by counsel for appellant cover the point.

Mr. Miller cites *Ives vs. Hamilton* (92 U. S., p. 426; 23 Law Ed., p. 494), which he calls a *conclusive citation*. We have carefully examined this case and we cannot find anything in it that is any broader or any more applicable to the case at bar than the text of the rule invoked by the appellant, to wit: that the mere changing of a *position* of an element in a machine does not avert infringement, where the parts transposed perform the same function after the change as before. In the *Ives* case the Court simply found as a fact, that the pivoting of the lower end of the saw, below the cross-head, instead of above it, did not affect the operation of the machine; that is to say: that



whether the element, to wit: the saw, was pivoted to the pitman above or below the cross-head was not a material change in any sense. We say that, in our judgment, this law cannot be applied to the arms "7" and "24" or "4," and the link "19" in the second device. They are differently constructed, arranged differently, operate differently; they do not perform the same functions, notwithstanding all of them accomplish the same old result of making a reversible window sash, which brings the case directly within that portion of Section 348 of *Walker on Patents*, which we have quoted. The Hauser device is a newer and better, and substantially a different combination of ingredients and elements.

In view of the fact that Judge Rudkin in his decree in dismissing the bill (page 17, Tr.), states that he had considered all of the evidence produced at the trial, we think the apology offered by counsel for appellant, for Judge Rudkin's decision in the case, is not called for. As a matter of fact, Judge Rudkin gave very careful attention to the evidence and remarks and discussions that arose at the trial and thoroughly understood the theory of the plaintiff and the defendants. It is true that Judge Rudkin did not pass specifically upon the question of invention, which he doubtless held to be unnecessary, in view of the fact that in his judgment there was no infringement of either of the patents sued on. The importance of



the case to the appellee Hauser, who was acting in good faith under his junior patent, must be our excuse for the very detailed discussion by us of the questions involved.

All of which is respectfully submitted.

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